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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

007287.00020

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

09/691792

Filed

October 18, 2000

First Named Inventor

Yakov Kamen

Art Unit

2421

Examiner

Dominic D. Saltarelli

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Stephanie L. Knapp/

Signature

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

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Typed or printed name

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September 11, 2009

Date

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 1 forms are submitted.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:	Atty. Docket No.: 007287.00020
<b>Yakov Kamen <i>et al.</i></b>	
Serial No.: 09/691,792	Group Art Unit: 2421
Filed: October 18, 2000	Examiner: Dominic D. Saltarelli
For: METHOD AND SYSTEM FOR ADAPTIVE ELECTRONIC PROGRAMMING GUIDE	Confirmation No.: 5769

**Pre-Appeal Brief Request For Review**

U.S. Patent and Trademark Office  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

***Remarks***

Having received and reviewed the Final Office Action dated June 19, 2009 (hereinafter "Office Action", and the Advisory Action dated September 2, 2009 (hereinafter "Advisory Action", Applicants respectfully submit that the standing rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005.

The pending rejections fail to address all the claim limitations, and exhibit clear factual and legal errors with respect to the cited references. The specific error relied upon in this Pre-Appeal Brief Request for Review includes the following:

- The Office made clear error in relying on the combination of U.S. Patent No. 5,798,785 to Hendricks (hereinafter "Hendricks") in view U.S. Patent No. 5,793,368

to Beer (hereinafter “Beer”) in its rejection of claims 10-22 as discussed in Applicants’ Response and Request for Reconsideration dated August 17, 2009, at pp. 5-6. Independent claim 10 recites, among other features,

receiving, at the broadcast receiving device, a user request to modify an electronic programming guide configured to display the electronic programming guide data;  
receiving, at the broadcast receiving device, one or more presentation criteria for making the user requested modification from the broadcast source; and  
determining, at the broadcast receiving device, at least one of the one or more presentation criteria corresponds to the user request.

- The Office Action alleges that the combination of Hendricks and Beer discloses all of the features of independent claim 10. Applicants respectfully disagree. The Office Action relies on Hendricks to show the claimed step of “receiving, at the broadcast receiving device, one or more presentation criteria for making the user requested modification from the broadcast source.” *See* Office Action, page 4. The Office Action concedes that “Hendricks fails to disclose receiving a user request to modify an electronic programming guide.” *Id.* Further, the Office Action alleges that Beer teaches the claimed steps of receiving, at the broadcast receiving device, a user request to modify an electronic programming guide and the “determining” step. *Id.* The Office Action relies on col. 3, lines 16-67 of Beer to show the claimed “determining” step. Specifically, the Office Action states that Beer describes “user requests for presentation criteria are a user request for a particular visual style or characteristic.” *Id.*
- The Advisory Action alleges that a determining step is one which interprets the user input in order to act upon it. *See* Advisory Action, page 3. The Advisory Action further alleges that “[s]ince the user input is selection criteria, a matching process is carried out which identifies which presentation criteria was selected, if any.” *Id.*
- Notably, claim 10 recites, “receiving, at the broadcast receiving device, *a user request to modify an electronic programming guide,*” and “receiving, at the broadcast receiving device, one or more presentation criteria for making the user

requested modification from the *broadcast source*.” Nowhere does claim 10 recite “user requests for presentation criteria,” as the Office Action suggests.

- Furthermore, even assuming, without conceding, that the processor in Beer corresponds to the claimed broadcast receiving device, at most, Beer discloses a user being able to select from a variety of different visual styles for a user interface on a processor or application on a processor, by adding, deleting, and changing attributes for widgets or objects associated with the user interface. *See*, Beer, col. 3, lines 16-17. Nowhere in Beer is there a teaching or suggestion that the processor determines at the broadcast receiving device, at least one or more presentation criteria corresponds to the user request, as recited in claim 10.
- Moreover, even assuming without conceding that Beer discloses a matching process, which is carried out when a user requests presentation criteria, as alleged in the Advisory Action, nowhere in Beer is there a teaching or a suggestion that the matching process occurs at the broadcast receiving device. Accordingly, Beer fails to teach or suggest the determining step as claimed.
- Hendricks fails to cure the deficiencies of Beer. The Action concedes that Hendricks fails to disclose receiving a user request to modify an electronic programming guide configured to display the electronic programming guide data. Accordingly, it then follows that, Hendricks can not *determine*, at the broadcast receiving device, at least one or more of the presentation criteria *corresponds to the user request*, as recited in claim 10. Therefore, claim 10 is patentably distinct over Hendricks in view of Beer.
- Claims 11-13 depend from independent claim 10 and are allowable for at least the same reasons as discussed above with respect to claim 10 and further in view of the additional novel and non-obvious features recited therein.
- Independent claims 14 and 18 recite language substantially similar to claim 10 and are thus allowable for substantially similar reasons as those discussed above with respect to claim 10. Claims 15-17 and 19-22 depend from claims 14 and 18, respectively, and are thus allowable for at least the same reasons as their respective

base claims, and further in view of the additional novel and non-obvious features recited therein.

While Applicants believe that the above points represent the clearest errors made by the Office, Applicants reserve the right to appeal on other bases and errors. Applicants further reserve the right to address the rejections of any other claims not identified above on appeal should the appeal of this case proceed after the Office's consideration of this paper.

### ***Conclusion***

All issues having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (202) 824-3130.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: September 11, 2009

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